

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:
Rosenblum et al.

Serial No.: 09/320,156

Filed: May 26, 1999

For: IMMUNOTOXINS DIRECTED AGAINST
c-erbB-2 (HER-2/Neu) RELATED
ANTIGENS

Group Art Unit: 1642

Examiner: Canella, K.

Atty. Dkt. No.: CLFR:092US

RESPONSE TO OFFICE COMMUNICATION DATED MAY 19, 2005

U.S. Patent and Trademark Office
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Commissioner:

In response to the Notice Under 37 CFR 1.251 – Pending Application which was mailed on May 19, 2005, requesting a copy of papers which cannot be located after a reasonable search (a copy of which is enclosed):

Applicants submit herewith the Appeal Brief dated 1/17/03 along with copies of the transmittal letter, post card, and post card stamped by the Office. Also enclosed is a copy of the Supplementary Response which was filed via facsimile, in further response to the Final Office Action and in response to the Examiner's Answer to the appeal brief filed January 17, 2003.

Such papers are a complete and accurate copy of applicant's record of such papers, and Applicants are not aware of any correspondence between the Patent Office and Applicants after May 8, 2003.

It is believed that no fee is due; however, should any fees under 37 C.F.R. §§ 1.16 to 1.21 be required for any reason, the Commissioner is authorized to deduct said fees from Fulbright & Jaworski L.L.P. Account No.: 50-1212/CLFR:092US.

Respectfully submitted,



Charles P. Landrum
Reg. No. 46,855
Agent for Applicants

FULBRIGHT & JAWORSKI L.L.P.
600 Congress Avenue, Suite 2400
Austin, Texas 78701
(713) 651-5391
(713) 651-5246 (facsimile)

Date: June 3, 2005



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/320,156 | 05/26/1999 | MICHAEL ROSENBLUM | D5425CIP2 | 4227 |

7590 05/19/2005

David L Parker
FULBRIGHT & JAWORSKI LLP
600 Congress Avenue Suite 2400
Austin, TX 78701



EXAMINER

CANELLA, KAREN A

ART UNIT PAPER NUMBER

1642

DATE MAILED: 05/19/2005

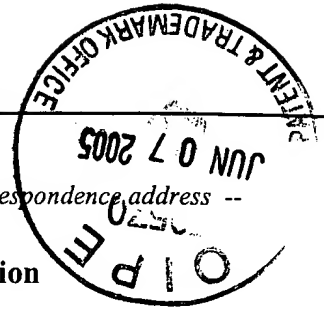
Please find below and/or attached an Office communication concerning this application or proceeding.

| | |
|-------------------|-------------|
| RECEIVED | |
| Date(s) Docketed: | 01/19/05 |
| MAY 24 2005 | |
| Client: | CLFR: 092US |
| Attorney(s): | D.P. CL |
| Initials: | GP |



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

NOTICE UNDER 37 CFR 1.251 - Pending Application

☐ The file on the cover sheet cannot be located after a reasonable search. Therefore, the Office is initiating the reconstruction of the file of the above-identified application pursuant to the provisions of 37 CFR 1.251.

Applicant is hereby requested to provide a copy of applicant's record (if any) of all of the correspondence between the Office and applicant for the above-identified application (except for U.S. patent documents), a list of such correspondence, and a statement that the copy is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and whether applicant is aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

☒ The following paper(s) pertaining to the above-identified application cannot be located after a reasonable search:

The Appeal Brief dated 1/17/03.

Therefore, the Office is initiating the reconstruction of such paper(s) pursuant to the provisions of 37 CFR 1.251.

Applicant is hereby requested to provide a copy of the paper(s) listed above and a statement that the copy of such paper(s) is a complete and accurate copy of applicant's record of such paper(s).

If applicant does not possess any record of the correspondence between the Office and the applicant for the file listed on the cover sheet or any copy of the paper(s) listed, applicant must reply to this notice by providing a statement that applicant does not possess any record of the correspondence between the Office and the applicant for the above-identified application.

☐ A printout from PALM of the contents of the file of the above-identified application is included with this notice.

Direct the reply to this notice to:

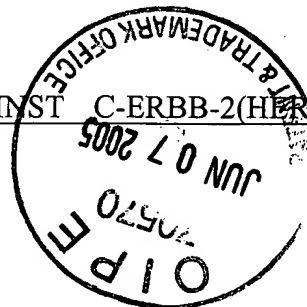
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1-(888)-786-0101

PTO Doc. Code: R251.NTC (Rev. 03/05)

In re Application of: Rosenblum, Michael et al.Application No.: 09320156Filing Date: 05/26/99Title: IMMUNOTOXINS DIRECTED AGAINST C-ERBB-2(HER-2/NEU
RELATED SURFACE ANTIGENSDirect to: U. S. Patent and Trademark Office
Mail Stop: Duplicates
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450**NOTICE UNDER 37 CFR 1.251 – Pending Application****Statement (check the appropriate box):**

☐ The copy submitted with this reply is a complete and accurate copy of applicant's record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and applicant for the above-identified application that is not among applicant's records.

☐ The copy of the paper(s) listed in the notice under 37 CFR 1.251 is/are a complete and accurate copy of applicant's record of such paper(s).

☐ The papers produced by applicant are applicant's complete record of all of the correspondence between the Office and the applicant for the above-identified application (except for U.S. patent documents), and applicant is not aware of any correspondence between the Office and the applicant for the above-identified application that is not among applicant's records.

☐ Applicant does not possess any record of the correspondence between the Office and the applicant for the above identified application.

Date_____
Signature_____
Typed or printed name**A Copy of this notice should be returned with the reply.**

Burden Hour Statement: This collection of information is required by 37 CFR 1.251. The information is used by the public to reply to a request for copies of correspondence between the applicant and the USPTO in order to reconstruct an application file. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This form is estimated to take 60 minutes to complete. This time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | |
|-------------------------------------|---|-------------|
| APPLICANT: Rosenblum, <i>et al.</i> | § | ART UNIT: |
| | § | 1642 |
| FILED: May 26, 1999 | § | |
| | § | EXAMINER: |
| SERIAL NO.: 09/320,156 | § | Canella, K. |
| | § | |
| FOR: Immunotoxins Directed Against | § | DOCKET: |
| c-erbB-2 (HER-2/Neu) Related | § | D5425CIP2 |
| Surface Antigens | § | |

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CERTIFICATE OF FACSIMILE TRANSMISSION

I certify that this response was transmitted via Facsimile to Examiner Karen Canella at the Patent Office at Tel. No. 703-746-5195 on the date below.

May 8, 2003
Date

Benjamin Aaron Adler
Benjamin Aaron Adler, Ph.D., J.D.

SUPPLEMENTARY RESPONSE

Dear Sir:

In further response to the Final Office Action mailed May 23, 2002, and in response to the Examiner's Answer to the appeal brief filed January 17, 2003, mailed April 22, 2003, please enter the following amendments and consider the following remarks. Reconsideration of the pending claims is respectfully requested.

AMENDMENTS

IN THE CLAIMS:

Please amend claim 15 as follows:

15. (amended) A composition comprising a conjugate of tumor necrosis factor to a single chain antibody exhibiting binding specificity for an extracellular epitope of c-erbB-2 protein, wherein said single chain antibody is scFv-23.

Please cancel claim 18.

REMARKS

Status of the Claims

Claims 15-19 are pending on appeal. Claims 15-17 and 19 are rejected. The rejection of claim 18 is withdrawn. Claim 18 is objected to for being dependent on a rejected claim. Claim 15 is amended herein. Claim 18 is canceled.

Attached hereto is a marked-up version of the changes made to the claims by the current amendments. The attached page is captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE". No new matter has been added. Reconsideration of the pending claims is respectfully requested.

Amendments to the claims

Claim 15 is amended to incorporate the elements of claim 18, which is objected to as being dependent on a rejected claim, to overcome prior art rejections of claims 15-17 and 19 under 35 U.S.C. §103(a). No new matter has been added.

The 35 USC §103 rejections

Appealed claims 15 and 19 stand rejected under 35 USC §103(a) as unpatentable over **Bacus et al.** (USP 5,514,554, effective filing date 9/27/91) in view of **Rosenblum et al.** (*Cancer Communications*, 1991) and **Hudziak et al.** (*Molecular and Cellular Biology*, 1989); appealed claims 15-17 and 19 stand rejected under 35 USC §103(a) as unpatentable over **Wels et al.** (USP 5,571,894, effective filing date 7/15/91) in view of **Hoogenboom et al.** (*Biochimica et Biophysica Acta*, 1991, Vol. 4, pp. 345-354) and **Hudziak et al.** (*Molecular and Cellular Biology*, 1989). Applicant respectfully traverses these rejections in view of the claim amendments.

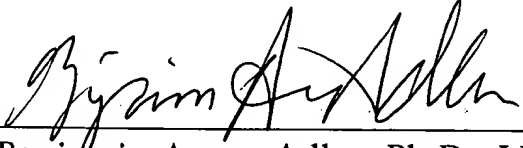
Applicant thanks the Examiner for reviewing and reconsidering the claims on appeal. The Examiner has withdrawn the rejection of

claim 18. In response, Applicant has incorporated the elements of dependent claim 18 into amended claim 15. Applicant respectfully submits that amended claim 15, and accordingly dependent claims 16-17 and 19, are in condition for allowance. Accordingly, Applicant respectfully requests that the rejection of claims 15-19 as obvious under 35 U.S.C. §103(a) be withdrawn.

This is intended to be a complete response to the Final Office Action mailed May 23, 2002, and to the Examiner's Answer to the appeal brief filed January 17, 2003, mailed April 22, 2003. If any issues remain outstanding, the Examiner is respectfully requested to telephone the undersigned attorney of record for immediate resolution.

Respectfully submitted,

DATE: May 8, 2003
ADLER & ASSOCIATES
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Houston, Texas 77071
(713)-270-5391 (tel.)
(713)-270-5361 (facs.)
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Benjamin Aaron Adler, Ph.D., J.D.
Registration No. 35,423
Counsel for Applicant

VERSION WITH MARKINGS TO SHOW CHANGES MADE

IN THE CLAIMS:

Please amend claim 15 as follows:

15. (amended) A composition comprising a conjugate of tumor necrosis factor to ~~an~~ a single chain antibody exhibiting binding specificity for an extracellular epitope of c-erbB-2 protein, wherein said single chain antibody is scFv-23.

Please cancel claim 18.

Application No. (if known):09/320,156

Attorney Docket No.: CLFR:092US

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I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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on June 3, 2005
Date



Signature

Charles P. Landrum

Typed or printed name of person signing Certificate

46,855
Registration Number, if applicable

(713) 651-5391
Telephone Number

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

Response to Office Action Dated May 19, 2005

COPY of Appeal Brief (and related transmittal letter/post card)
filed 01/17/2003

Supplementary Response dated May 8, 2003